

U.S. Government Resources for Intellectual Property Rights (IPR) Protection in the U.S. and Abroad

Reporting IPR Crimes Domestically

U.S. Department of Justice: Intellectual property crime, such as copyright piracy, trademark counterfeiting, or internet fraud, like any other crime, should be reported to appropriate law enforcement investigative authorities at the local, state, federal, or international levels, depending on the scope of the crime. Citizens or companies aware of federal crimes should report them to local offices of federal law enforcement. Federal law enforcement agencies have offices conveniently located in every state. In general, federal crimes, which include IPR crimes, may be reported to the local office of an appropriate law enforcement agency by telephone call and by requesting the “Duty Complaint Agent”. Contact information regarding these local offices may be found at 202-324-3000 or www.cybercrime.gov/reporting.htm.

National Intellectual Property Rights Coordination Center: If a company learns of infringement occurring in the United States, it should contact the National Intellectual Property Rights Coordination Center at 202-344-2410 or fax 202-344-1920. The IPR Center is a multi-agency center responsible for coordinating a unified U.S. Government response regarding IPR enforcement issues. Investigative personnel provide core staffing from Immigration and Customs Enforcement (ICE) and the Federal Bureau of Investigation (FBI). If a company has specific information concerning IPR crimes, it can complete a complaint form at <http://www.ice.gov/graphics/cornerstone/ipr/IPRForm.htm>. Companies may also contact the Center by mail or telephone:

U.S. Immigration and Customs Enforcement
National Intellectual Property Rights Center
1300 Pennsylvania Avenue, NW, RM 3.5A
Washington, DC 20229
Phone: 202-344-2410
Fax: 202-344-1920

U.S. Food and Drug Administration: The Food and Drug Administration (FDA) Office of Criminal Investigations (OCI) investigates counterfeiting involving drugs, medical devices, foods, blood and biologic products. If a company or consumer finds an FDA regulated product to be counterfeit they should contact this office for further investigation:

Food and Drug Administration, Office of Criminal Investigations
7500 Standish Place
Rockville, MD 20855

Tel: (301) 294-4030

IPR Protection Abroad

The first step for protection of intellectual property is for the rightholder, whether a company or individual, to file for relevant patents or trademarks. Patents and trademarks must be filed in each country where protection is sought. Copyrights may also be registered, but registration is not required for protection if the country in question is a member of the Berne Convention. Copyright registration provides evidence of ownership.

Various U.S. Government agencies, including the Department of Commerce, Department of State, the U.S. Patent and Trademark Office, U.S. Copyright Office and the United States Trade Representative have IPR experts who regularly work with companies to help them protect their intellectual property. Teams from these agencies also work directly with foreign governments to enforce IPR trade agreements, raise IPR concerns bilaterally and conduct IPR training.

Seeking Assistance with Counterfeit or Pirated Products

The Trade Compliance Center and Commerce Department country experts stand ready to work with U.S. firms to help them protect their intellectual property at home and abroad. Commerce experts can suggest strategies to evaluate IPR problems encountered abroad and will work with our Embassies around the world to pursue a course of action for resolution of the problems. Commerce established a special telephone and web address designed specifically to deal with companies' international intellectual property concerns. Companies can contact Commerce at:

U.S. Department of Commerce
Trade Compliance Center
14th Street and Constitution Avenue, NW
Washington, DC 20230

Phone: 1-866-999-HALT (4258)

Steps for Protecting Intellectual Property Globally

It is important to note that intellectual property rights are generally territorial. That is, a U.S. patent or trademark provides protection only in the United States; a Japanese patent provides protection only in Japan, etc. This means that, in most cases, the first step in protecting intellectual property beyond U.S. borders is for companies to register their trademark or patent with the appropriate authorities in each country where they seek protection or through international treaties that are administered by the World Intellectual Property Organization (WIPO).

We recommend that companies seek assistance from an attorney familiar with the

intellectual property laws of the country or countries where they are interested in conducting business to determine the costs and benefits of registration. The U.S. Department of Commerce can put companies in contact with U.S. Embassies overseas in order to help companies locate local patent and trademark attorneys.

Obtaining Patents and Trademarks Abroad: For more information on how to apply for patents or trademarks in a foreign country, contact the intellectual property office in that country directly. A list of contact information for most intellectual property offices worldwide can be found at www.wipo.int/news/en/links/addresses/ip/index.htm. Once a company has registered for protection, it can use that country's local laws to enforce its rights.

Obtaining Patents Abroad in Multiple Countries with a Single Application: The Patent Cooperation Treaty (PCT) streamlines the process for U.S. inventors and businesses wishing to obtain patent protection in other countries. By filing one patent application with the U.S. Patent and Trademark Office (USPTO), U.S. applicants can concurrently seek protection in up to 115 countries. For an invention made in the United States, U.S. law prohibits filing abroad without a foreign filing license from the USPTO, unless six months have elapsed since filing a U.S. application. For filing an international patent application under the PCT, visit the USPTO website: www.uspto.gov/go/pct/. Additional information on the PCT is also available on the WIPO website: www.wipo.org/pct/en/index.html (Note: The international application itself does not lead to any patent protection in any country. It simply serves as a vehicle for centralized pre-processing of the application. Each application still must be reviewed and approved by each participating country.)

Obtaining Trademarks Abroad in Multiple Countries with a Single Application: The Madrid Protocol streamlines the process for U.S. trademark owners wishing to obtain trademark protection in other countries. By filing one international trademark application with the U.S. Patent and Trademark Office (USPTO), U.S. applicants can concurrently seek protection in up to 66 countries. Changes to a registration, e.g., transfers, name or address changes of renewals can be handled through a single procedural step. For filing an international trademark application under the Madrid Protocol, visit the USPTO website: <http://www.uspto.gov/web/trademarks/madrid/madridindex.htm>. Additional information on the Madrid Protocol is also available on the WIPO website: <http://www.wipo.int/madrid/en/> (Note: The international application itself does not lead to any trademark protection in any country. It simply serves as a vehicle for centralized pre-processing of the application. Each application still must be reviewed and approved by each participating country.)

Registering Copyrights Abroad

Although most countries do not require copyright registration in order to enjoy copyright protection, registration can offer several benefits, such as proof of ownership. For information on registering a literary or artistic work for copyright protection abroad contact the U.S. Copyright Office at: 202-707-5959 or www.copyright.gov.

Enforcement: Using Local Laws

Once a company has registered its patent or trademark, it can use local laws to enforce its rights. Copyright protection may also be enforced using local laws. Enforcement can be through civil suits, criminal investigations and prosecutions, or administrative procedures, where available. Generally, a company will need to work with the country's law enforcement authorities or through its courts to initiate investigations and lawsuits. Because of the legal complexities involved with IPR protection, it is suggested that the advice of an IPR lawyer be sought where needed. Countries must ensure that its IPR laws are implemented effectively and are consistently enforced.

China IPR Resources**Contacting the U.S. Embassy for Resources in China:**

The U.S. Embassy in Beijing and our Foreign Commercial Service (FCS) offices in China can provide in-country information about IPR enforcement resources. Companies can go directly to the FCS-China website at: <http://www.buyusa.gov/china/en/> On this webpage, there are links to "Business service providers in China for U.S. companies," including legal services and investigative services. Also, FCS and the U.S. Embassy in Beijing have created an "IPR Toolkit" that provides more information on IPR protection specific to China:

<http://www.usembassy-china.org.cn/ipr>

China: Additional Remedies When a Company Does not Hold Patent or Trademark Protection

If a company does not hold patents or trademarks in China, there may be remedies available in China based on other types of rights and laws. A company should obtain local counsel to explore possible legal actions. The U.S. Embassy in Beijing can assist U.S. companies looking for attorneys who specialize in Chinese intellectual property rights protection.

Questions that may be asked in pursuing additional remedies include the following:

- Have safety issues been identified as a result of the counterfeit products?
- Is the product Underwriters Laboratories (UL) certified (or other certification mark)? If so, and the counterfeit bears the UL mark, there is a counterfeiting problem of another company's mark. UL has an aggressive anti-counterfeiting program that can help.
- Does the product falsely indicate it is made in America? If so, there may be a violation of the unfair competition laws.
- Does the product bear the barcode of the legitimate product? If so, there may be

administrative measures available regarding false barcoding.

- Are there distinctive packaging materials or perhaps an instructional brochure? If so, there may be copyright protection, and a possible basis for U.S. Customs seizures.
- Is there false General Administration of Quality Supervision, Inspection and Quarantine (AQSIQ) certification? (Note: AQSIQ is the Chinese law-enforcement administrative organ of the State Council in the field of quality, metrology, entry-exit commodities inspection, entry-exit health quarantine, entry-exit animal and plant quarantine, certification and accreditation and standardization.) If so, there may be Chinese product quality law remedies available.
- Is the mark famous/well-known? Some international protection may be available. (Note: “Well-known” trade and service marks enjoy protection in most countries against signs that are considered a reproduction, imitation or translation of that mark provided that they are likely to cause confusion in the relevant sector of the public. Well-known marks are usually protected, irrespective of whether they are registered or not, in respect of goods and services which are identical with, or similar to, those for which they have gained their reputation.)
- Are new product designs being developed? If so, design patent protection may be available.
- Are there security devices/commercial strategies, etc., that the company can use to protect its name regardless of IP rights - controlling marketing channels, identifying legitimate/preferred suppliers/ strategies at trade shows, etc.?

Trade Agreements on Intellectual Property Rights

Our international trade agreements, such as the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs), and related international property rights treaties, require member countries to provide for means by which rights holders can protect and enforce their IPR.

The following website contains the text of the TRIPs Agreement:

www.tcc.mac.doc.gov/cgi-bin/doit.cgi?204:64:144408919:272

From the following website you can find the links to many international IPR treaties:

<http://www.tcc.mac.doc.gov/cgi-bin/doit.cgi?219:64:758548003:0:TOVR!-!Intellectual%20Property%20Agreements!-!Issues!-!Intellectual%20Property>

The Trade Compliance Center (TCC) at the U.S. Department of Commerce works with foreign governments to ensure that IPR infringements are not the result of the abrogation of international trade agreements. The TCC also monitors countries' implementation of IPR trade agreements. The TCC actively participates in World Trade Organization

discussions regarding international IPR treaties and participates in trade negotiations to ensure U.S. IPR interests are represented. To contact the TCC to discuss trade agreement concerns, call 202-482-1191.

IPR Protection in the United States

The U.S. Department of Commerce's International Trade Administration and U.S. Patent and Trademark Office, U.S. Copyright Office, U.S. Customs and Border Protection, U.S. Department of Justice and the National Intellectual Property Rights Coordination Center are U.S. government agencies that can assist with IPR problems encountered domestically.

Steps for Protecting Intellectual Property Domestically

Obtaining a U.S. Patent: The first step in ensuring protection of intellectual property is registering for protection at the U.S. Department of Commerce's Patent and Trademark office (USPTO). A U.S. patent is the grant of a property right to the inventor(s) of an invention, issued by the USPTO. The right conferred by the patent grant is "the right to exclude others from making, using, offering for sale or selling" the invention in the United States or "importing" the invention into the United States. To get a U.S. patent, an application must be filed with the USPTO. For more information on filing for a patent in the United States contact: 1-800-786-9199 or 703-308-4357 or www.uspto.gov To file electronically with the USPTO visit: www.uspto.gov/ebs/efs/index.html.

Obtaining a U.S. Trademark: A trademark is a word, phrase symbol or design, or combination of words, phrases, symbols or designs, that identifies and distinguishes the source of the goods of one party from those of others. A service mark is similar to a trademark except that it identifies and distinguishes the source of a service rather than a good. The U.S. Patent and Trademark Office (USPTO) reviews trademark applications and determines whether an application meets the requirements for federal registration. The USPTO does not decide whether a company or individual has the right to *use* a mark (which differs from the right to register). Even without registration an individual or company may still use any mark adopted to identify the source of its goods and/or services. For more information on filing for a trademark in the United States contact: 1-800-786-9199 or 703-308-4357 or www.uspto.gov To file with the USPTO electronically visit: www.uspto.gov/teas/index.html.

Registering a Copyright: Copyrights reserve to authors the exclusive control of their "writings", such as literary, musical, pictorial and audiovisual works, including computer programs, for a fixed period of time. Although copyright protection is automatic, registration can offer several benefits, such as proof of ownership. For information on securing a U.S. copyright registration, contact:

U.S. Copyright Office
Phone: 202-707-5959

Website: www.copyright.gov.

Stopping Infringing Imports at the U.S. Border: Once a company secures a trademark registration from the U.S. Patent and Trademark Office (USPTO), or a copyright from the U.S. Copyright Office, the registration should be recorded with U.S. Customs and Border Protection (CBP). Recordation of a federally registered trademark or copyright significantly aids in the border enforcement of such rights by making it easier for CBP officials to identify infringing goods. U.S. law provides for seizure of pirate and counterfeit goods at the border, and provides various procedures for requesting assistance from CBP to prevent pirate and counterfeit goods from entering the United States. The recordation fee is \$190.

Applications to record a trademark, copyright, or trade name must be in writing and should be addresses to:

U.S. Customs and Border Protection
Office of Regulations and Rulings
Intellectual Property Rights Branch
1300 Pennsylvania Avenue, N.W.
Mint Annex
Washington, D.C. 20229
Phone: 202-572-8710; fax: 202-344-1873

An applicant wishing to record an intellectual property right with CBP may refer to the CBP website for further information and for forms that may be used to complete a recordation: www.cbp.gov. The Intellectual Property Rights Branch e-mail address is hqiprbranch@dhs.gov. Additional information on how CBP can assist in protecting a company's IPR is available at:
http://www.customs.gov/xp/cgov/import/commercial_enforcement/ipr/ipr_enforcement/.

Exclusion Order: Companies may also want to consult with their legal counsel to discuss whether filing a Section 337 complaint with the U.S. International Trade Commission (USITC) may be useful for their particular situation. Section 337 declares the infringement of certain statutory IPR and other forms of unfair competition in import trade to be unlawful practices. Most Section 337 investigations involve allegations of patent or registered trademark infringement; however, it is also available for copyright infringement. In the event that the USITC determines that Section 337 has been violated, it may issue an exclusion order barring the products at issue from entry into the United States, as well as a cease and desist order directing the violating parties to cease certain actions, when appropriate. USITC provides information on Section 337 at:
<http://info.usitc.gov/337>

The USITC also has a Trade Remedy Assistance Office (TRAO) that provides information to small businesses concerning the remedies and benefits available under U.S. trade laws and provides technical and legal assistance and advice to eligible small

businesses to assist them in preparing and filing Section 337 complaints. TRAO can be reached by telephone at 800-343-9822 or 202-205-2200, or by facsimile at 202-205-2139.

Additional IPR-related Websites

Office of the U.S. Trade Representative (USTR)

www.ustr.gov

Trade Compliance Center (TCC)

<http://www.tcc.mac.doc.gov>

World Trade Organization (WTO)

<http://www.wto.org/>

WTO Agreement on the Trade-related Aspects of Intellectual Property Rights (TRIPs)

http://www.wto.org/english/tratop_e/trips_e/trips_e.htm

World Intellectual Property Organization (WIPO)

Headquartered in Geneva, Switzerland, WIPO is one of the 16 specialized agencies of the United Nations system of organizations. It administers 23 international treaties dealing with different aspects of intellectual property protection. 180 nations, including the United States, are member states.

<http://www.wipo.int/>